



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,987	05/25/2001	Iok-Hou Pang	1719F US	6461

26356 7590 02/13/2003

ALCON RESEARCH, LTD.
R&D COUNSEL, Q-148
6201 SOUTH FREEWAY
FORT WORTH, TX 76134-2099

EXAMINER

FAY, ZOHREH A

ART UNIT	PAPER NUMBER
----------	--------------

1614

DATE MAILED: 02/13/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,987

Applicant(s)

PANG, IOK-HOU

Examiner

Zohreh Fay

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____.

Art Unit:

Claims 8-14 are presented for examination.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8, 9, 11 and 12 are rejected under 35 U.S.C. 102 (b) as being anticipated by Takeda Chem Ind, Ltd (MT on PTO-1449). Takeda Chemical teaches the use of the claimed neurotrophic factor stimulator in a pharmaceutical formulation for the treatment of neuropathy and retinal diseases. The above reference makes clear that the claimed composition and the use thereof is old and well known.

Claim 8, 11 and 12 are rejected under 35 U.S.C. 102 (b) as being anticipated by Yan et al.(U.S. Patent 5,641,749). Yan et al. Teach the use of a neurotrophic factor for the treatment of retina or optic neuropathy caused by glaucoma. See page 5, paragraph 8 and page 6 paragraphs 9-13. The oral and topical administration is also taught by the above reference. See claim 10.

a. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 14 are rejected under 35 U.S.C. 103 as being unpatentable over Rathone et al. In view of Yan et al. (U.S. Patent 5,641,749).

Art Unit:

Rathone et al. Teach the use of the claimed neurotrophic factor, AIT-082 in a pharmaceutical formulation as a neuroprotective agent. See page 369, column 1 and the entire article. The above reference differs from the claimed invention in the use of such compound for protection of retina optic nerve and different routes of administration. Yan et al. Teach neurotrophic factors have been previously used for the treatment of retina or optic neuropathy caused by glaucoma, and they can be used by oral or topical administration. See page 5, paragraph 8 and page 6 paragraphs 9-13. It would have been obvious to a person skilled in the art to employ a well known neuroprotective agent for the protection of optic and retinal nerve head, considering that the secondary reference teaches the use of neurotrophic factors for the treatment of retina or optic neuropathy due to the conditions, such as glaucoma is old and well known. The secondary reference also teaches that the oral or topical use of such composition..

One skilled in the art would have been motivated to combine the teachings of the above references, since one relates to the use of the claimed compound as a neurotrophic stimulator and the other relates to the use of neurotrophic stimulators in the treatment of retina or optic head neuropathy. The substitution of one neurotrophic stimulator for another would have been obvious to a person skilled in the art in the absence of evidence to the contrary. Applicant has presented no evidence to establish the unexpected or unobvious nature of the claimed invention, and as such, claims 10 and 14 are properly rejected under 35 U.S.C. 103.

Art Unit:

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Fay whose telephone number is (703) 308-4604.

ZOHREN FAY
PRIMARY EXAMINER
GROUP 1200



Z.F

February 6, 2003